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TRANSMITTAL FORM

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Application Number	10/767,784
Filing Date	January 29, 2004
First Named Inventor	Galley
Art Unit	1614
Examiner Name	Ward, Paul V
Attorney Docket Number	21453

Total Number of Pages in This Submission

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
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- ☐ Drawing(s)
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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Kimberly J. Prior
Signature	Kimberly J. Prior
Date	06/05/2006

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Typed or printed name	Kimberly J. Prior		
Signature	Kimberly J. Prior	Date	06/05/2006

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Inventors: Galley, et al.

Group: 1614

Serial No. 10/767,784, filed January 29, 2004
(Ref. No. 21453)

Examiner: Ward, Paul V.

For: **MALONAMIDE DERIVATIVES**

RESPONSE TO RESTRICTION REQUIREMENT

Nutley, New Jersey 07110
Date: June 5, 2006

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This election is filed in response to the Restriction Requirement issued May 5, 2006, in connection with the above-identified patent application. A response to this Restriction Requirement is due June 5, 2006. Applicants respectfully request consideration of the following remarks.

Claims 1 to 24 are pending. The claims have been restricted to the following forty-two groups.

I. The compounds according to claim 1 of formula IA, wherein C is phenyl.

II. The compounds according to claim 1 of formula IA, wherein C is pyridinyl.

III. The compounds according to claim 1 of formula IA, wherein C is furanyl or tetrahydrofuranyl.

IV. The compounds according to claim 1 of formula IA, wherein C is benzo[b]thiophenyl.

V. The compounds according to claim 1 of formula IA, wherein C is tetrahydronaphthyl.

VI. The compounds according to claim 1 of formula IA, wherein C is indanyl.

VII. The compounds according to claim 1 of formula IA, wherein C is 2,2,dimethyl-[1,3] dioxolanyl.

VIII. The compounds according to claim 1 of formula IB, wherein C is phenyl.

IX. The compounds according to claim 1 of formula IB, wherein C is pyridinyl.

X. The compounds according to claim 1 of formula IB, wherein C is furanyl or tetrahydrofuranyl.

XI. The compounds according to claim 1 of formula IB, wherein C is benzo[b]thiophenyl.

XII. The compounds according to claim 1 of formula IB, wherein C is tetrahydronaphthyl.

XIII. The compounds according to claim 1 of formula IB, wherein C is indanyl.

XIV. The compounds according to claim 1 of formula IB, wherein C is 2,2,dimethyl-[1,3]dioxolanyl.

XV. The process for preparing a compound formula IA according to claim 22, wherein C is phenyl.

XVI. The process for preparing a compound formula IA according to claim 22, wherein C is pyridinyl.

XVII. The process for preparing a compound formula IA according to claim 22, wherein C is furanyl or tetrahydrofuranyl

XVIII. The process for preparing a compound formula IA according to claim 22, wherein C is benzo[b]thiophenyl.

XIX. The process for preparing a compound formula IA according to claim 22, wherein C is tetrahydronaphthyl.

XX. The process for preparing a compound formula IA according to claim 22, wherein C is indanyl.

XXI. The process for preparing a compound formula IA according to claim 22, wherein C 2,2, dimethyl-[1,3] dioxolanyl.

XXII. The process for preparing a compound formula IB according to claim 23, wherein C is phenyl.

XXIII. The process for preparing a compound formula IB according to claim 23, wherein C is pyridinyl.

XXIV. The process for preparing a compound formula IB according to claim 23, wherein C is furanyl or tetrahydrofuranyl.

XXV. The process for preparing a compound formula IB according to claim 23, wherein C is benzo[b]thiophenyl.

XXVI. The process for preparing a compound formula IB according to claim 23, wherein C is tetrahydronaphthyl.

XXVII. The process for preparing a compound formula IB according to claim 23, wherein C is indanyl.

XXVIII. The process for preparing a compound formula IB according to claim 23, wherein C is 2,2, dimethyl-[1,3]dioxolanyl.

XXIX. The method of treating according to claims 20-21 of formula IA, wherein C is phenyl.

XXX. The method of treating according to claims 20-21 of formula IA, wherein C is pyridinyl.

XXXI. The method of treating according to claims 20-21 of formula IA, wherein C is furanyl or tetrahydrofuranyl.

XXXII. The method of treating according to claims 20-21 of formula IA, wherein C is benzo[b]thiophenyl.

XXXIII. The method of treating according to claims 20-21 of formula IA, wherein C is tetrahydronaphthyl.

XXXIV. The method of treating according to claims 20-21 of formula IA, wherein C is indanyl.

XXXV. The method of treating according to claims 20-21 of formula IA, wherein C is 2,2, dimethyl-[1,3] dioxolanyl.

XXXVI. The method of treating according to claims 20-21 of formula IB, wherein C is phenyl.

XXXVII. The method of treating according to claims 20-21 of formula IB, wherein C is pyridinyl.

XXXVIII. The method of treating according to claims 20-21 of formula IB, wherein C is furanyl or tetrahydrofuranyl.

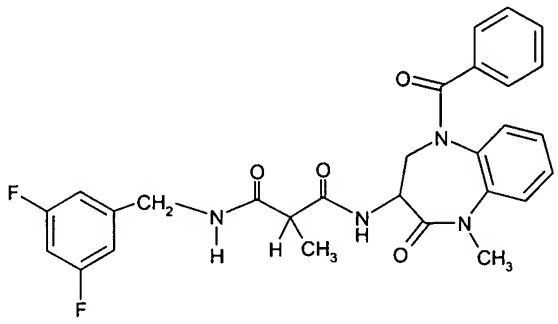
XXXIX. The method of treating according to claims 20-21 of formula IB, wherein C is benzo[b]thiophenyl.

XL. The method of treating according to clams 20-21 of formula IB, wherein C is tetrahydronaphthyl.

XLI. The method of treating according to claims 20-21 of formula IB, wherein C is indanyl.

XLII. The method of treating according to claims 20-21 of formula IB, wherein C is 2,2, dimethyl-[1,3] dioxolanyl.

Applicants hereby elect with traverse Group I, claims 1 to 6, 9 to 14, and 17 to 19, directed to compounds of formula IA wherein C is phenyl and compositions containing them, and the species N-(5-Benzoyl-1-methyl-2-oxo-2,3,4,5-tetrahydro-1H-benzo[b][1,4]diazepin-3-yl)-N'-(3,5-difluoro-benzyl)-2-methyl-malonamide (Example 14), having the following structure:



. Claims 1 to 3, 11, 12, and 17 to 19 read on the elected species.

The requirements are traversed for the following reasons. Upon an election of species, M.P.E.P. § 803.02 states that if no prior art is found that anticipates or renders obvious the elected species, search and examination of the claims will be extended to the extent necessary to

determine patentability of the generic claim. Thus, Applicants understand that if no art is found which anticipates or renders obvious the elected species, search and examination will be expanded to the extent necessary to determine patentability of the generic claim or at least to the extent necessary to determine patentability of Group I.

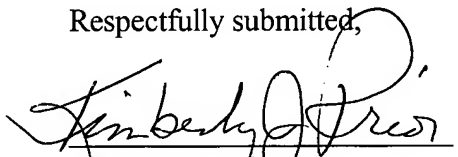
Further, method claims 20 to 24 have been restricted from the product claims as Groups XV to XLII. In accordance with M.P.E.P. § 821.04, Applicants understand that upon the finding of an allowable compound claim, those claims of Groups XV to XLII having all of the limitations of the allowable product claim will be rejoined and examined on the merits.

The foregoing amendment is fully responsive to the Restriction Requirement issued May 5, 2006. Early and favorable consideration is earnestly solicited.

No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,



Kimberly J. Prior
Attorney for Applicant(s)
(Reg. No. 41,483)
340 Kingsland Street
Nutley, New Jersey 07110
Telephone: (973) 235-6208
Telefax: (973) 235-2363

236237